

### **REMARKS**

Claims 13-27 are pending. Claims 13, 15-17, 19-21 and 24-24 were amended solely to improve their form. Claims 25-27 were amended to further define the present invention, and claims 14, 18 and 22 were amended accordingly. Withdrawal of the outstanding rejection is respectfully requested for at least the reasons set forth below.

No new matter was added. Regarding claims 25-27, Javascript is, by definition, a scripting language. See the attached definitions in the web page printout from GOOGLE in Appendix A of this response.

### **Request for Interview Prior to Formal Action on Amendment**

Applicants request an interview prior to formal action on this response. An "Applicant Initiated Interview Request Form" accompanies this response. Please contact Applicants' undersigned representative to schedule the interview.

### **Rejections under 35 U.S.C. § 102**

All pending claims were rejected again under 35 U.S.C. § 102(e) as allegedly being anticipated by Pettersen. Applicants respectfully traverse this rejection.

In the response filed January 4, 2007, Applicants presented a "Declaration of Prior Invention to Overcome Cited Patent" under 37 CFR § 1.131 (hereafter, "the Declaration") to swear behind the earliest effective date of Pettersen, which is July 15, 2000, the filing date of Pettersen's patent application. In the Final Rejection, the Examiner responded by stating that the submitted documentation is insufficient to show reduction to practice of the claimed invention. In the previous response filed September 4, 2007, Applicants rebutted the Examiner's position. In the outstanding Office Action, the Examiner presents a revised explanation regarding why the Declaration is insufficient.

1. The Declaration and Supplemental Declaration shows that the “claimed” invention was reduced to practice

In the previous two Office Actions, the Examiner argued that the Declaration does not show that the “claimed” invention was reduced to practice. Applicants fully responded to this assertion in the previous response. To further bolster the previous arguments, a “Supplemental Declaration of Prior Invention...” accompanies this response and includes a claim chart to explicitly identify where the claim features appear in the previously submitted documentation, namely, the Appendix A source code and the Exhibit 2 Affiliate Setup Instructions. Applicants believe that this Supplemental Declaration addresses all of the items highlighted by the Examiner on pages 7-8 of the outstanding Office Action.

Furthermore, the Appendix A source code and the Exhibit 2 Affiliate Setup Instructions are fully functional if run on any general-purpose computer, and thus constitutes a showing that the method, apparatus and article of manufacture existed and worked for its intended purpose. In fact, Exhibits 2 and 3 were provided explicitly to show that the invention existed and worked for its intended purpose prior to the earliest effective date of Pettersen.

2. No showing of “diligence” is required by Applicants

In the outstanding Office Action, the Examiner repeats his explanation that the submitted evidence lacks a showing of “diligence.” Applicants fully responded to this issue in the previous response by explaining that the showing being made by the Applicants establishes a reduction to practice prior to the effective date of the reference, and thus no showing of diligence is required. Diligence is only required if the showing being made by the Applicants is that conception, not reduction to practice, occurred prior to the critical date. See 37 CFR 1.131(b), which reads as follows (underlining, and bolded italics added for emphasis):

**§ 1.131 Affidavit or declaration of prior invention**

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim... may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based...

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference,

or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application...

Furthermore, the USPTO has even produced a PowerPoint presentation (attached hereto as Appendix B and available at: [www.uspto.gov/web/patents/biochempharm/documents/hill.pps](http://www.uspto.gov/web/patents/biochempharm/documents/hill.pps)) that states this fact. See Slide 13 on page B4 of Appendix B which refers to Diligence and states "Not required after reduction to practice."

Applicants respectfully request that the Examiner withdraw the requirement to show diligence.

In sum, the Examiner's conclusion that Applicants' showing is inadequate is misplaced. Reconsideration of this conclusion and withdrawal of the prior art rejection is respectfully requested.

### Conclusion

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. A Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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(Date)

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define: javascript

**APPENDIX A**(to Amendment in response to  
October 31, 2007 Office Action  
for Application No. 09/923,923)[Sign in](#)**Web**Related phrases: [client-side javascript](#) [server-side javascript](#) [javascript style sheets](#) [javascript api](#) [javascript forums](#)**Definitions of javascript on the Web:**

- A scripting language produced by Netscape for use within HTML Web pages.  
[orafaq.cs.rmit.edu.au/glossary/faqglosj.htm](http://orafaq.cs.rmit.edu.au/glossary/faqglosj.htm)
- A scripting language commonly used in web pages. Most search engines are unable to index these scripts properly.  
[www.searchmaestros.com/articles/article4.html](http://www.searchmaestros.com/articles/article4.html)
- JavaScript is a programming language that is mostly used in web pages, usually to add features that make the web page more interactive. When JavaScript is included in an HTML file it relies upon the browser to interpret the JavaScript. ...  
[www.servicom.com.my/glossary.htm](http://www.servicom.com.my/glossary.htm)
- JavaScript is a scripting language developed by Netscape. JavaScript can make web pages more animated and dynamic in terms of graphics and navigation. One of the most common graphic JavaScript effects is called a mouseover, and Javascript navigation is commonly created using drop-down menus.  
[www.web-design-tips.info/webdesign\\_glossary.html](http://www.web-design-tips.info/webdesign_glossary.html)
- A scripting programming language best known for its use in websites, although it is also used to enable scripting access to objects embedded in other applications.  
[studio.brightcove.com/library/help/glossary\\_help.cfm](http://studio.brightcove.com/library/help/glossary_help.cfm)
- JavaScript is a programming language used for creating web pages.  
[www.kerio.com/manual/kmsug/en/go01.html](http://www.kerio.com/manual/kmsug/en/go01.html)
- JavaScript is a programming language that is mostly used in web pages and is essentially a somewhat limited scripting version of Java, in much the same way as VB Script is a limited, scripting version of Microsoft's Visual Basic.  
[www.w3-hosting.net/resources/web-hosting-glossary.html](http://www.w3-hosting.net/resources/web-hosting-glossary.html)
- JavaScript is a client-side scripting language that allows dynamic behavior to be specified within HTML documents. Most browsers support java however some browsers are disabled for JavaScript use.  
[www.emerge-solutions.com/learning\\_glossary.htm](http://www.emerge-solutions.com/learning_glossary.htm)
- A Web scripting language developed by Netscape. It was developed independently of the full JAVA language and is an "open" language, free for anyone to use and adapt. For example, The Java Script Source has many scripts people can adapt for their own purposes.  
[mason.gmu.edu/~montecin/netterms.htm](http://mason.gmu.edu/~montecin/netterms.htm)
- JavaScript is a cross-platform, object-based scripting language developed by Netscape for client and server applications. It is commonly used on web pages to add interactivity and dynamic content such as

banner rotation.

[www.2020systems.com/internet-ad-glossary-e-q.html](http://www.2020systems.com/internet-ad-glossary-e-q.html)

- A common computer programming language developed by ECMA for use in web applications primarily on the client. Javascript is relatively small and fast and is the most common language used for providing interactivity for web sites.

[www.aboutsearchenginerankings.com/glossary\\_of\\_terms.htm](http://www.aboutsearchenginerankings.com/glossary_of_terms.htm)

- A Web scripting language developed by Netscape. JavaScript shares selected attributes and data structures with the Java programming language; however, it was developed separately, and it is not Java. JavaScript works within an HTML page, and is supported by Netscape versions 3.0 and higher. ...

<https://www.ncsbn.org/836.htm>

- The broadest and most general term, which encompasses all subsets mentioned on this page.

[www.webstandards.org/action/dstf/definitions/](http://www.webstandards.org/action/dstf/definitions/)

- A scripting language which enables web designers to add dynamic, interactive elements to a web site.

[www.theregister.co.uk/offers/hosting/glossary.html](http://www.theregister.co.uk/offers/hosting/glossary.html)

- A scripting language used to embed executable instructions in a web page.

[www.cs.cornell.edu/wya/DigLib/MS1999/glossary.html](http://www.cs.cornell.edu/wya/DigLib/MS1999/glossary.html)

- An object-oriented scripting language supported by popular web browsers. JavaScript is an ISO standard.

[www.aardvarkmedia.co.uk/glossary.html](http://www.aardvarkmedia.co.uk/glossary.html)

- The standard scripting language built into all the major modern browsers.

[ajaxpatterns.org/Terminology](http://ajaxpatterns.org/Terminology)

- an open scripting language that enables Web authors to design interactive sites. Can interact with HTML source code and is supported by most browsers.

[www.gslis.utexas.edu/~vlibrary/glossary/index.html](http://www.gslis.utexas.edu/~vlibrary/glossary/index.html)

- A scripting language that allows lines of programming code to be inserted into HTML to add interactivity and other features to Web pages. The scripts are executed by the user's browser, not by the Web page server.

[www.ncga.coop/glossary/6](http://www.ncga.coop/glossary/6)

- A simple web programming language created by Netscape that enables small applications to run on different types of computers and operating systems. Currently, search engines do not record the content inside a JavaScript object.

[www.anduro.com/glossary.html](http://www.anduro.com/glossary.html)

- JavaScript is a programming language that is loosely based on Java. Instead of being referred to in an HTML document, as Java applets are, JavaScript code is embedded in the document itself, using the SCRIPT element.

[web.mit.edu/hotmetal\\_v3.0/www/Chapter15.html](http://web.mit.edu/hotmetal_v3.0/www/Chapter15.html)

- A programming language for use in webpages that allows the use of dynamic content. In spite of the similarity in name to Java, it is not closely related to Java.

[tech-terms.com/index.php](http://tech-terms.com/index.php)

- JavaScript is an object-based, client-side scripting language developed by Netscape. Embedded in the

head section of a web document, it can produce interactivity to a web page dynamically.

[www.dakno.com/glossary.php](http://www.dakno.com/glossary.php)

- A programming language designed for use with web pages to add 'functionality' eg to create drop-down menus, process information input by users. Approx. 84% of browsers have it (at summer 2000).

[www.volresource.org.uk/swit/webterm.htm](http://www.volresource.org.uk/swit/webterm.htm)

- JavaScript is a programming or script language, which can be imbedded in Web pages and read by the browser. It can be used to do things such as open a separate browser window or to display a message when the mouse moves over an object on the page.

<https://my.calstrs.com/MyCalSTRSWebUI/WebUISupportFiles/HelpFiles/Glossary.htm>

- JavaScript is the name of Netscape Communications Corporation's and now the Mozilla Foundation's implementation of the ECMAScript standard, a scripting language based on the concept of prototype-based programming. ...

[en.wikipedia.org/wiki/JavaScript](http://en.wikipedia.org/wiki/JavaScript)

Find definitions of **javascript** in: [Chinese \(Simplified\)](#) [Chinese \(Traditional\)](#) [Dutch](#) **English** [French](#) [German](#) [Italian](#) [Portuguese](#) [Russian](#) [Spanish](#) [all languages](#)

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define: javascript

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**APPENDIX B**  
(to Amendment in response to  
October 31, 2007 Office Action  
for Application No. 09/923,923)

HTML printout from: [www.uspto.gov/web/patents/biochempharm/documents/hill.pps](http://www.uspto.gov/web/patents/biochempharm/documents/hill.pps)  
Printout date: April 30, 2008, Original presentation date: unknown

**37 CFR 1.131** Declarations

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What will be covered?

- When is a declaration under **37 CFR 1.131** appropriate?
- Who can file a declaration under **37 CFR 1.131**?
- What must a declaration under **37 CFR 1.131** establish?
- An Unusual Situation

**37 CFR 1.131**

- “When any claim of an application...is rejected, the inventor of the subject matter of the rejected claim...may submit an appropriate oath or declaration **to establish invention of the subject matter of the rejected claim prior to the effective date of the reference...**” (emphasis added).

Purpose of Declarations Under **37 CFR 1.131**

Swearing behind a reference

### Inappropriate Situations for a 131 Declaration

- The rejection is based upon a statutory bar
  - Reference is prior art under:
    - 35 U.S.C. 102(b)
    - 35 U.S.C. 102(d)
    - 35 U.S.C. 102(f)
    - 35 U.S.C. 102(g)

### Inappropriate Situations for a 131 Declaration

- Reference is:
  - U.S. Patent
  - Published U.S. Patent Application
- And:
  - Claims the same patentable invention
    - Same in a 35 U.S.C. 102 sense
    - Obvious in a 35 U.S.C. 103 sense

### Appropriate Situations for a 131 Declaration

- Reference is:
  - Prior art applied under 35 U.S.C. 102(a) or (e)
    - By another
- And:
  - Does not claim the same patentable invention

### Who Must Sign a Declaration Under **37 CFR 1.131**?

- The inventor of the subject matter of the rejected claim
- The owner of the patent under reexamination
- A party qualified under 37 CFR 1.42, 1.43, or 1.47
  - 1.42 – legal representative of dead inventor
  - 1.43 – legal representative of insane or legally incapacitated inventor
  - 1.47 – appropriate representative when an inventor refuses to sign



## What Must a Declaration Under **37 CFR 1.131** Show?

- Prior Invention
  - What the inventors did
  - When they did it
- Where the work was done

## Prior Invention

- Reduction to practice of the invention
- Conception of the invention coupled with diligence to actual reduction to practice
- Conception of the invention coupled with diligence to the filing of the application

## Evidence of Conception or Reduction to Practice

- Attached sketches
- Attached blueprints
- Attached photographs
- Attached reproductions of notebook entries
- An accompanying model
- Attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon
- Testimony given in an interference
- Disclosure document (MPEP 1706)

## Dates

- Conception or Reduction to Practice:
  - Actual dates
  - Allegation of actions prior to a specific date
  - Can be redacted from the evidence
    - Must be dealt with in the body of the declaration
- Diligence
  - Actual dates required

## Diligence

- Coupled with conception
- Only after conception is established
- Prior to effective date of reference to reduction to practice
  - Actual
  - Constructive
- Not required after reduction to practice



## Diligence

- Actual dates required
- Allegation not enough
- Evidence of facts establishing diligence
- No degrees of diligence
  - All activity and inactivity should be explained and supported

## Where must acts relied upon be carried out?

- United States
- NAFTA Country
  - Not before December 8, 1993
- WTO Member Country
  - Not before January 1, 1996

## How much of the claimed invention needs to be shown?

- Depends on the claim and the reference
- General rule as to generic claims
  - Many times would not apply to chemical or biotechnology applications
- Species claim
  - Reference species
    - Same
    - Different
- Genus claim
  - Reference species
  - Reference genus

## Seasonable Presentation

- Prior to final
- Before appeal where no final is present
- After final
  - With first response to new ground of rejection in final
  - Showing under 37 CFR 1.116(c) or 37 CFR 1.195
  - With 37 CFR 1.129(a) request

## An Unusual Situation

- Inventor A at company XYZ invents M and N and files an application disclosing M and N but only claiming M
  - XYZ decides that N cannot be commercialized – so it is not claimed
- Inventor B at company XYZ modifies N to N' (commercially feasible)
- Patent on M issues
- Subsequently (after 11/29/99) but less than one year after patent on M issues, B files an application to N'

## An Unusual Situation Continued

- N' is not obvious over M
- N' is obvious over N
- Examiner rejects claims to N' under 35 U.S.C. 103 using the disclosure of A's patent
- Can B invoke the new 103(c) and just provide a statement of common ownership at the time the invention N' was made?

## An Unusual Situation Continued

- Answer: NO
  - 103(c) is invoked when the reference is **only** prior art under 102(e), (f), and (g)
  - Here 102(a) also applies
- Solution:
  - Declaration under **37 CFR 1.131** to “swear behind” the issue date of the reference
    - No longer prior art under 102(a)
  - Statement of common ownership at the time the invention N' was made

Thank You!!